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EXAMINER

MICHALSKI, SEAN M

ART UNIT

PAPER NUMBER

3724

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/741,521	<b>Applicant(s)</b> VEGLIANTE ET AL.	
	<b>Examiner</b> SEAN M. MICHALSKI	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,8-10 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 8-10, 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/11/2009 has been entered.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 09/970,015 in view of Lucas (5,440,961) as set forth 07/03/2007.

Applicant filed a Terminal Disclaimer over application number 09/790,015 which is ineffective at overcoming the double patenting rejection based on 09/970,015. This was set forth clearly in the Final Rejection dated 06/11/2009.

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 8-10, 12-15, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas in view of Wankow (3,549,066; hereinafter Wankow) with supporting evidence from Boda (5,524,515), Union (4,210,043) Tsai (5,036,740) as set forth in the action dated 07/03/07.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas in view of Wankow (3,549,066; hereinafter Wankow) with supporting evidence from Boda (5,524,515), Union (4,210,043) Tsai (5,036,740) as set forth above, and further in view of Chuang (4,960,022) as set forth in the action dated 07/03/07.

7. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas in view of Wankow (3,549,066; hereinafter Wankow) with supporting evidence from Boda (5,524,515), Union (4,210,043) Tsai (5,036,740) as set forth above, and further in view of Chiu (5,398,576) as set forth in the action dated 07/03/07.

8. Claims 1, 2, 10, 12-15, 18 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022 and an artifact submitted by a third party on 8/25/2008, entered into the record as "09741521MA") in view of Lucas (US 5,440,961) in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as set forth in the previous action.

Chuang teaches a film cutter apparatus (figure 3B) comprising an elongated rail base with a pair of elongated rails formed at the top thereof (see figure 3A) and a channel formed within said rail base and between said rails (seen in figure 3A). Chuang further discloses a blade housing including an upper portion (308A and 323 in figure 3C respectively). Chuang further discloses the upper housing houses (329 figure 3C) a blade (319 and 320) the bottom edge of the upper portion protrudes on either side of the blade (as seen in figure 3C). Chuang discloses that the blade is angled from the bottom edge of the upper portion (319, 320; as seen in figure 3C and figure 3D). Chuang discloses that the upper portion of the housing has a grip surface being a concave shape, as seen in figure 3C. Chuang discloses that the rail base includes a depression (elements 302-306 as seen in figure 3A define 'depressions') capable of receiving a cover of a carton of film.

Chuang does not disclose that the end surface of the upper housing is 'curved', but that it is angled (see figure 3C).

It would have been obvious to one of ordinary skill in the art at the time of the invention to make the angle as seen on the bottom surface of the upper housing in figure 3C rounded upwardly instead of angled upwardly. This is an obvious design choice that one of ordinary skill in the art could make with no undue experimentation. A designer would simply select 'curved' over 'angled' and the function would be the same, it would just have a slightly different appearance. A designer could have decided to create a curve for it's aesthetic appearance with no change to the function of the tool.

Chuang discloses that the lower portion of the blade housing is moveable in the channel (figures 3A-3C).

Examiner has a model of Chuang, which was submitted by a third party. The rails of this model appear to be rigid vinyl, or rigid plastic of some kind. The entirety of the apparatus is made from one material. The "rails are formed of a first material which provides an attraction to plastic wrap received over said rails", capable of "attracting said plastic wrap received over said rails for clinging said plastic wrap to said rails before, during and after cutting of said plastic wrap by sliding said blade housing within said channel". Examiner has witnessed this first hand, by pulling plastic wrap across the rails, and pressing down on the blade housing moving the blade housing across the plastic to cut it.

Though the disclosure of Chuang is silent as to the particular material chosen (for the "second material"-that of the base), the model uses what is clearly rigid plastic, rigid vinyl or rigid PVC of some kind.

Examiner takes official notice that a person of ordinary skill in the art would have known about the materials vinyl and PVC and their properties such as strength and elasticity and cost.

Vinyl and PVC are both known materials, the selection of a specific material for a base rail would be within the level of ordinary skill in the art, since it has been held to be within the general skill of a worker in the art to select a known component or material on the basis of suitability for the intended use as a matter of obvious mechanical design expediency. *In re Leshin*, 125 USPQ 416. Also see MPEP 2144.07. *Sinclair & Carroll Co. v. Interchemical Corp.* states "Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle." 325 U.S. at 335, 65 USPQ at 301.). Since the base material is of a standard design and use, the designation of a specific material does nothing to enhance the patentability of a design.

Lucas discloses using a second material applied to the top surface of a rail style cutter in order to increase the friction thereon, and therefore increase the attachment/cling/adhesion/attraction of a film to the top surface of the rails of the cutter. See the figures which show an adhesive/attractive/high friction material on both top rails of the rail style cutter (figure 1). See also a description of the intent of the added

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friction/adhesion at column 3 lines 1-17. Lucas discloses "urethane tape" or "other coatings or tapes" maybe used.

It would have been obvious to one of ordinary skill in the art to add a "first" material layer to the top rails of Chuang to enhance the cling/attraction/adhesion properties of the rails, as taught by Lucas.

Neither Chuang nor Lucas discloses "polyvinyl chloride comprising at least 10% plasticizer".

Lucas discloses "urethane tape" or "other coatings or tapes" maybe used. The suggestion contained within this comment is that any material known to a person of ordinary skill that would enhance the "cling" of plastic wrap to the top rails of a rail style cutter can be added thereto in order to enhance the cutting of the cutter, by providing for a more securely attached and held plastic wrap.

Chuang is also concerned with providing a secure adhesion/attraction between the film and the rail, as seen by the wheels which press down enhancing the static cling experienced by the plastic wrap.

Wankow discloses a plasticized vinyl chloride (Table I, the fifth 'spot material' lists "plasticized vinyl film"). Also in column 3, the term "vinyl" in the specification is defined to mean "vinyl chloride and copolymers...". It should also be noted that in the art vinyl chloride *means* polyvinyl chloride, since monovinyl chloride is not a final product—substantially always an intermediate since monovinyl chloride is toxic and hazardous to human health. Wankow discloses that the materials can be "print[ed]..paint[ed]...on the carton". The material is for adhesion/attraction/cling of plastic wrap to a spot.



It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a polyvinyl chloride with plasticizer material as the “coating or tape” specifically motivated, suggested and requested by Lucas for the purpose of adhering/causing to cling/ attracting plastic wrap to a rail, since Wankow discloses that a polyvinyl chloride with plasticizer will work to attract/adhere/cause to cling plastic wrap thereunto.

Lucas in view of Wankow does not disclose that the plasticizer exceeds 10%. Polyvinyl chloride having plasticizer exceeding 10% is a **known material** by persons of ordinary skill in the art. See the footnote “a” of “**Phthalate Ester Plasticizers-Why and How They Are Used**” page 8, which explicitly discloses the known use of 40% plasticizer in PVC (polyvinyl chloride) at least as early as January 1973.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use plasticizer exceeding 10%, since it has been held that discovering an optimum result of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980), **and/or in addition or alternatively** since it has been held to be within the general skill of a worker in the art to select a known component or material on the basis of suitability for the intended use as a matter of obvious mechanical design expediency. *In re Leshin*, 125 USPQ 416. Also see MPEP 2144.07. *Sinclair & Carroll Co. v. Interchemical Corp.* states “Reading a list and selecting a known compound to meet known requirements is no more ingenious than selecting the last piece to put in the last opening in a jig-saw puzzle.” 325 U.S. at 335, 65 USPQ at 301.).

Lucas does not disclose that the adhesive or frictional material is “co-extruded” with the base rail, but that the material is “adhered” thereto.

Wankow discloses that the polyvinyl chloride may be “print[ed]..paint[ed]...on the carton, but does not disclose "co-extrusion" as a means to apply one PVC compound onto another.

Gearhart discloses “coextrusion” for the forming together into one piece two different PVC layers, by extruding each layer from a different hopper into the same die, as seen in the figures. Column 1 lines 14-18 describes that coextruding two kinds of PVC allows two different materials (with somewhat different properties) to be utilized at two different zones.

It would have been obvious for a person having ordinary skill in the art to coextrude the first material with the second material, as disclosed by Gearhart, since it is a known method for adhering two different PVC materials together to form a singular whole.

Regarding claim 10, Chuang does not disclose a rivet connecting the blade to the left and right sides of the housing. Instead Chuang uses adhesive.

Examiner takes official notice that adhesive is a functional equivalent of a rivet, and that they can be substituted at will.

It would have been obvious to one of ordinary skill in the art to use a rivet instead of adhesive, since either would work as well as the other and the two are art recognized equivalents.

Regarding claim 12, the blade of Chuang appears to be approximately 30 degrees. It is at least at some angle above 0 and below 90.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an angle of 30 degrees, since it has been held that discovering an optimum result of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 13, the lower portion of Chuang is clearly a tracking device capable of slidably moving in the channel.

Regarding claims 14 and 15, the channel and tracking device of Chuang are not “tubular” which typically at least means “generally cylindrical”. Chuang discloses a T-shaped tracking device with a middle portion attaching the T portion (lower portion/tracking device) to the upper portion. Chuang does disclose that the middle portion is of a predetermined length, since it is designed to fit within the channel as that is designed (see figure 3C of Chuang). The main feature of the tracking portion and channel is that they are *corresponding* shapes.

Examiner takes official notice that a person of ordinary skill in the art knows about a number of different shapes, such as tubular/tubes/cylinders and rectangular prisms.

A person of ordinary skill in the art would have made the tracking device and channel any corresponding shape, such as tubular, elongated trapezoid, rectangular prism or any other common shape known generally to persons of ordinary skill in the

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art, since the design need is only that the channel and tracking device correspond to one another, and one shape works just as well as any other.

9. Claims 1, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022) in view of Lucas (US 5,440,961) in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as set forth above and further in view of Urion (4,210,043) as set forth in the previous action.

Chuang (US 4,960,022) in view of Lucas (US 5,440,961) in view of Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) does not use acetal as the material for the blade housing.

Urion discloses using acetal as the material for a sliding rail style cutting blade holder/housing (see column 7 lines 35-40), since it is economical.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use Acetal as the material for the blade housing of the Chuang-base combination, since it is a known material (Urion) for cutting blade holder (Urion) which is economical.

10. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang (US 4,960,022) in view of Lucas (US 5,440,961), Wankow (US 3,549,066), "Phthalate Ester Plasticizers-Why and How They Are Used", and Gearhart (US 4,856,975) as set forth above, and further in view of Chiu (5,398,576) as set forth in the previous action.

Chuang (US 4,960,022) does not disclose endcaps, instead using an integrally formed stopper internal to the rail.

Chiu (5,398,576) discloses endcap 33.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide releasable end caps as taught by Chiu in lieu of integral stoppers as seen in Chuang, since doing so allows for the blade housing to be released from the rail without destroying either. The endcap of Chiu is a replacement for (and equivalent to) the integral stopper of Chuang.

### ***Response to Arguments***

11. Applicant's arguments filed 12/11/2009 have been fully considered but they are not persuasive.

Applicant alleges that the use of Wankow is improper since the vinyl spots are not used in the cutting mechanism. While this is not admitted, it is also irrelevant. The Vinyl dots are used in the plastic wrap field of endeavor to hold plastic wrap in a “cohesive” (subject to cohesion) way. It is therefore a known material in the relevant art (attraction of plastic wrap), and it is on this basis that it lends itself for consideration as relevant prior art.

Applicants allege (pp. 8 of remarks 12/11/2009) there to be no “teaching, suggestion or motivation to combine the primary references Lucas and Wankow.” **Initially, this is not true-** a teaching is seen in the rejections as set forth; that is, the prior art teaches a material suitable for having plastic wrap cling to it—as *taught* by

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Wankow *on its face*. **Second**, applicant is attempting to rely solely upon the "teaching suggestion motivation" test which cannot be used to show patentability. Lack of "teaching suggestion or motivation" does not imply patentability; **showing** a teaching, suggestion or motivation **does** make the prima facie case of obviousness. Also within the rejection set forth on 7/3/07 was other rationales of obviousness (cited from MPEP 2143), including

(B) Simple substitution of one known element for another to obtain predictable results; (Using cohesive material from Wankow to replace adhesive material in the other art)

(E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (use in the prior art was to make something cling to the rail, only cohesion, adhesion and friction will allow such cling-- the selection of any one would be obvious as obvious to try)

Applicant alleges Hindsight reconstruction(pp. 8 of remarks 12/11/2009), since Lucas and Wankow are trying to solve problems from completely different directions. This is not persuasive, since the applicability of Wankow has been discussed at length, and it is clear on the record how Wankow is being used in the rejection.

Applicant alleges that there is no motivation to move the vinyl spots of Wankow to the tops of the rails of Lucas *coming from Wankow*. The motivation is not from Wankow—the motivation is from Lucas, which shows the sticky ("tape") or high friction

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material / (material to cause the wrap to “cling” to the rails) *located* on the rails—if the *material* is changed in Lucas, it will be adjusted in material composition only, as per the combination set forth. **Lucas explicitly suggests that other materials can be selected**, so long as they provide cling to the wrap----. If applicant truly does not understand this feature of the combination—the nature of the combination, applicant is earnestly invited to call examiner for clarification.

Applicant alleges (page 9, remarks 12/11/09) there to be no motivation upon reading Wankow to design the movable slide cutter of Lucas. That is irrelevant because Lucas teaches making the slide cutter of Lucas. Wankow need not suggest the creation of Lucas. Lucas is the base reference, and ***explicitly suggests using other materials on the rails to ensure cling of the wrap material to the rail.***

The allegations that follow regarding the Boda, Urion and Tsai references, on the balance of page 9 is not persuasive. The allegation that Chuang does not fix the deficiencies of the above (page 10) is not persuasive since there are no deficiencies, and also not persuasive in the same argument regarding Chiu (bottom of 10-page 11).

Applicant alleges that the rejection over prior art including Chiu to be deficient, since Chiu discloses only one endcap. This is irrelevant to the rejection as written.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Arguments regarding the Affidavit***

12. Regarding Page 15 of remarks portion, alleging the nexus of commercial success has been met, examiner disagrees again. Applicant alleges that nexus is met by a showing of 1) commercial success, and 2) the thing that is successful is the invention...

This fails to include the inherent requirement- that the success is shown to be a result of the features of the claims, and not some other action or element. Furthermore, the facts of the case do not support direct applicability to the current proceedings- the question of secondary considerations of Demaco Corp. v. F.Von Langsdorf (851 F.2d 1387) is based on an inter partes district court proceeding—not the administrative Ex Parte examination process. See MPEP 2145, which states:

“to be entitled to substantial weight, the applicant should establish a nexus between the rebuttal evidence and the claimed invention, i.e., objective evidence of nonobviousness must be attributable to the claimed invention. The Federal Circuit has acknowledged that applicant bears the burden of establishing nexus, stating:

‘In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant’s assertion that the sales constitute commercial success. C.f. Ex parte Remark, 15 USPQ2d 1498, 1503 ([BPAI] 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in ex parte



prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.' "

The evidence must be of a clear and convincing nature to overcome examiners prima facie case of obviousness. To be clear the evidence, as such, is being fully considered, but there is an insufficient showing that the sales of a few million pieces constitute a "commercial success", and also that the sales are based on the inventive features and not some other factor. Proving that the device according to claim 1 was sold is different than proving that it was sold because of the features of claim 1 as a whole. Perhaps all of the sales were based on price, shipping times, customer service. Perhaps some fraction was based on nothing more than the fact that the device was a slide cutter, and the inventive features of "cohesion" as opposed to "adhesion" did nothing to enhance the sale and a friction based or adhesive based rail (as in Lucas) would have sold just as well at the price you offered. Without this level of detail there cannot be a conclusion as to whether the sales constitute a commercial success based on the features of the invention, or whether it was based on some other factor.

Next, applicant misstates what the Affidavit shows- Applicant sets forth that "the PWMR demonstrates that by 2005, AEP's slide cutter penetrated 25 percent of a market dominated by huge and long established competitors". The affidavit actually attests that for a single 12 month period in 2005, 8% of the market was AEP's slide cutter as sold by Saran, and further *alleges* that Reynold's using a "copy" comprises 16% ( page 3 of the affidavit under heading 6) which is a conclusory statement. Affiant

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concludes that Reynolds's product is "infringing" the claim, but does not show any facts that this conclusion is based on. The **ultimate legal question** of anticipation may not be attested to with substantial weight, and affiant must support this conclusion with facts, which are not present.

Applicant alleges that it was wrong to refer to the estimates as "flawed" since the Federal Circuit has held estimates to be "proper indicia". This is not disputed- it is the nature of the evidence which is lacking. The estimate shows no raw data or methodology of the estimate, leading to the conclusion that the evidence is of little probative value, Not that it is excluded.

Applicant proffers that the exhibits I-N prove copying (Remarks page 16-17). The **ultimate legal question** of infringement may not be attested to with substantial weight, and affiant must support this conclusion with facts, which are not present. See the response to Elements 13-18 of the Affidavit below.

Regarding the Affidavit of 12/11/2009, element 1 requires no response.

Regarding the Affidavit of 12/11/2009, element 2 alleges that cohesion is different than friction and adhesion. This is irrelevant, since the claims do not require "cohesion"— they require "an attraction". Furthermore, in the context of the prior art—the combinations as set forth prove the prima facie obviousness of using a cohesive material. Cohesion and Adhesion and friction are functionally equivalent in the disclosed prior art since they are used for the same purpose—holding film to something. The use

of a cohesive rather than adhesive material is not above the level of ordinary skill, since both achieve the same effect and both are known.

Regarding the Affidavit of 12/11/2009, element 3, Affiant alleges Wankow teaches away from the present invention, since the cohesive material is used in manner different than that of the claims. Wankow is seen as evidence that one of ordinary skill knew of the cohesive material used by Wankow for the purpose of causing attraction of the film to a point-- the location of the attraction is irrelevant to the question of whether *use of the known material would be obvious in a different location*. the location is specified by different art, and in consideration of the teachings of Wankow, a cohesive material would be a known material, known to be used in *attracting plastic films*.

Regarding the Affidavit of 12/11/2009, element 4 requires no response.

Regarding the Affidavit of 12/11/2009, element 5 has no allegation or argument. It is the burden of applicant to make a clear and convincing argument. The arguments against this portion are presented in response to the remarks submitted with the affidavit, as set forth above.

Regarding the Affidavit of 12/11/2009, element 7, affiant may not attest to the ultimate legal question of anticipation or infringement of the accused infringers, and must show by evidence actual infringement in support of such a conclusion.

Regarding the Affidavit of 12/11/2009, element 8, "conservative estimates" is not valuable probative evidence, since it is conclusory and does not show estimation methodology or what specific source data was relied on.

Regarding the Affidavit of 12/11/2009, element 9, the estimate is not valuable probative evidence, since it is conclusory and does not show estimation methodology or what specific source data was relied on. The disclosure of evidence showing 9.6 million pieces sold is evidence of sales data, not commercial success. Simply being able to sell something does not elevate it to being a “commercial success”. The fact that you sold 9.6 million +/- is fully understood and considered against the strength of the cases of obviousness, and Examiner remains convinced of the obviousness of the invention.

Regarding the Affidavit of 12/11/2009, element 12 requires no response.

Regarding the Affidavit of 12/11/2009 element 13, the picture of I does not show each feature of claim 1 and is therefor not proven to be infringing.

Regarding the Affidavit of 12/11/2009 element 14, the picture of J does not show **any** feature of claim 1 and is therefor not proven to be infringing.

Regarding the Affidavit of 12/11/2009 element 15, the picture of K does not show each feature of claim 1 and is therefor not proven to be infringing.

Regarding the Affidavit of 12/11/2009 element 16, the exhibit L does not show **any** feature of claim 1 and is therefor not proven to be infringing.

Regarding the Affidavit of 12/11/2009 element 17, the exhibit M does not show each feature of claim 1 and is therefor not proven to be infringing. The referenced “claim 16” regarding the co-extrusion refers to a “tacky” material not as in the present application but as seen *in the prior art Lucas*.

Regarding the Affidavit of 12/11/2009 element 18, the exhibit N does not show each feature of claim 1 and is therefor not proven to be infringing.

Regarding the Affidavit of 12/11/2009, element 19 is not proved and is an allegation. As set forth above the supplied evidence is not sufficient to overcome the prima facie case of obviousness.

Regarding the Affidavit of 12/11/2009, element 20 requires no response.

***Conclusion***

13. This is a request for continued examination application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEAN M. MICHALSKI whose telephone number is (571)272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sean M Michalski/  
Examiner, Art Unit 3724

/Kenneth Peterson/  
Primary Examiner, Art Unit 3724